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In re Application of
SZU, et al.
Application No.: 09/744,289
PCT No.: PCT/US98/14976
Int. Filing Date: 20 July 1998
Priority Date: N/A
Attorney's Docket No.: 2026-4282US
For: VACCINES AGAINST ESCHERICHIA
COLI 0157 INFECTION

DECISION ON

PAPERS

UNDER 37 C.F.R. 1.42

This is a decision on applicants' "RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" filed 1 August 2001, which has been treated as a request for acceptance of the application filed on behalf of a deceased inventor under 37 C.F.R. 1.42.

BACKGROUND

On 20 July 1998, applicants filed international application PCT/US98/14976. A Demand electing the United States was filed with the International Preliminary Examining Authority within nineteen months of the priority date. Accordingly, the deadline for submitting the basic national fee to prevent abandonment of the international application as to the United States expired at midnight of 22 January 2001 (20 January 2001 was a Saturday).

On 22 January 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 6 February 2001, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors was required. This Notification set a one month extendable period for reply.

On 1 August 2001, applicants filed the instant "Response to Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)," including, *inter alia*, two combined declarations and powers of attorney, a copy of the notification and a check in the amount of \$1890.00 for a five month extension. One declaration is numbered 1/3, 2/3, 3/3, 4/3 with signatures from the two joint inventors and identifies Yvonne Ageyman Konadu as the "third joint inventor" and "as heir to the estate of

deceased inventor and applicant Edward Konadu.” The second declaration is numbered 1/4, 2/4, 3/4, 4/4 and identifies the third joint inventor as Edward Konadu and Yvonne Ageyman Konadu as “representative and heir to the estate of deceased inventor Edward Konadu.”

DISCUSSION

It is first noted that the application file contains an uncashed check in the amount of \$2252.00, which amount corresponds to the amount indicated in the transmittal letter that was submitted with the national stage papers on 22 January 2001. It is unclear why the check was not processed, though it is noted that the left side of the check was truncated. In any event, all required fees have been timely paid and accordingly, the check is being returned herewith.

Under 37 C.F.R. 1.497(a)(3), a declaration must identify, *inter alia*, each inventor. The declaration signed by the inventors Szu and Robbins is numbered 1/3, 2/3, 3/3, and 4/3. It is presumed, notwithstanding the incorrect page numbering, that page 4/3 was attached to the declaration at the time of execution by inventors Szu and Robbins. If this is incorrect, a new oath or declaration by Szu and Robbins is required in response to this decision.

Under 35 U.S.C. §117, legal representatives of deceased inventors may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor. The “legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.” 37 C.F.R. 1.42.

In the declaration signed by Yvonne Ageyman Konadu as “representative and heir” of Edward Konadu, a residence, citizenship and post office address are given, but it is not clear to whom they belong, that is to either Edward Konadu or Yvonne Konadu. Under 37 C.F.R. 1.497 and 37 C.F.R. 1.63, the declaration must include the residence, mailing address and citizenship of both the legal representative and the deceased inventor. Moreover, the declaration does not indicate that Ms. Konadu is the “legal representative” or “sole heir” of the deceased inventor. If a legal representative has been or is required to be appointed under applicable law, such person must sign the declaration and indicate the relationship, e.g., “legal representative of inventor Edward Konadu.” Otherwise, all heirs of Edward Konadu must sign the declaration and indicate the relationship, e.g., “sole heirs of Edward Konadu,” or “legal representative of Edward Konadu.”

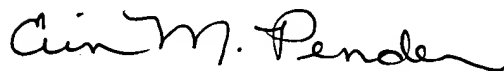
CONCLUSION

For the above reasons, the request for status under 37 C.F.R. 1.42 is **REFUSED**.

Applicant is required to submit an oath or declaration in compliance with 37 C.F.R. 1.497 and 1.42 within a time period of **TWO (2) MONTHS** from the mail date of this Decision. **THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 C.F.R. 1.136(a). FAILURE TO**

PROPERLY RESPOND WILL RESULT IN ABANDONMENT. Any request for reconsideration of this decision should include a cover letter entitled "Renewed Submission Under 37 C.F.R. 1.42."

Please direct any further correspondence with respect to this matter to the Commissioner of Patents and Trademarks, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



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Attachment: Check #21641 in the amount of \$2,252.00